

### **REMARKS/ARGUMENTS**

These remarks are made in response to the Office Action of August 22, 2007 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. However, the Examiner is expressly authorized to charge any deficiencies to Deposit Account No. 50-0951.

In the Office Action, Claim 6 was rejected under 35 U.S.C. § 112. Claims 1-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application 2003/0014668 to Faccin, *et al.* (hereinafter Faccin) in view of U.S. Published Patent Application 2005/0022007 to Guigi, *et al.* (hereinafter Guigi), and further in view of U.S. Published Patent Application 2005/0022007 to Phillips (hereinafter Phillips).

#### **Rejections Under § 112**

As previously noted, Claim 6 was rejected as an inconsistent dependent claim. Applicants express their gratitude for the Office Action pointing out this typographical error. In this response, Claim 6 has been amended to depend from Claim 4 to remove the inconsistency. Applicants therefore respectfully request withdrawal of this rejection.

#### **Amendments to the Claims**

Although Applicants respectfully disagree with the rejections in the Office Action, Applicants nonetheless have amended the claims in order to expedite prosecution of the present application by further emphasizing certain aspects of the claims. Applicants respectfully assert, however, that the claim amendments presented are not intended as, and should not be interpreted as, the surrender of any subject matter. Applicants are not conceding by these amendments that any previously submitted claims are unpatentable over the references of record. Applicants' present claim amendments are submitted only for purposes of facilitating expeditious prosecution of the present Application.

Accordingly, Applicants respectfully reserve the right to pursue any previously submitted claims in one or more continuation and/or divisional patent applications.

In this response, some of the claims have been amended to emphasize certain aspects. The independent claims have been amended to more clearly recite that communications between the mobile device are concurrently occurring between two different networks, a local wireless network and a mobile communications network. Such amendments are fully supported throughout the Specification. (See, e.g., FIG. 1.) Claims 20, 21, 23, and 24 have also been amended to maintain consistency among the claims. Claim 6 was amended as previously discussed. No new subject matter has been introduced by these amendments.

**Applicants' Invention Predates Guigui and Phillips**

Applicants respectfully disagree that the rejections asserted in the Office Action. Additionally, Applicants assert that any rejection under Phillips or Guigui, alone or in combination with any other reference, is moot because Applicants' invention predates the respective June 2, 2003 and August 26, 2003 effective dates of Phillips and Guigui.

Applicants conceived of their invention at least as early as April 29, 2003 and actively pursued its reduction to practice from a date prior to the effective dates of Phillips and Guigui. In support of their assertions of conception, diligence, and constructive reduction to practice, Applicants submit the Declarations attached hereto in accordance with 37 CFR § 1.131 along with other supporting evidence of Applicants' diligence in pursuing the present Application. The Declarations provide the sworn testimony of the Applicants affirming their conception and continuing diligence from a time prior to the effective dates of Phillips and Guigui to the filing of the Application.

Along with these Declarations, Applicants also submit herewith a copy of a confidential invention disclosure, No. BOC8-2003-0067, titled "Authentication of a

wireless device using cellular network, SIP, and Parlay methods", authored by Inventor Hilf (hereinafter Disclosure). The Disclosure was submitted on May 5, 2003, by Applicants to a Patent Attorney/Intellectual Property (IP) Professional employed by the assignee of Applicants' invention, International Business Machines Corporation (IBM). The Disclosure was insubstantially modified on May 8, 2003. The description of the invention in the Disclosure, however, was not modified after the Disclosure was initially submitted. Indeed, as noted below, established IBM procedures for handling all such disclosures preclude any modification to the description of the invention once it has been submitted by an inventor. The Disclosure has not been revised subsequent to May 8, 2003.

The Disclosure explicitly describes Applicants' invention. The written description provided in the Disclosure is clear evidence of Applicants' conception of the claimed subject matter at least as early as April 29, 2003.

The Disclosure is an IBM confidential disclosure form. As such, it is a standardized document that, according to established IBM procedures, is used by IBM inventors to document the conception of an invention. Strictly-followed internal procedures established by IBM govern the use of all such confidential disclosure forms. One aspect of IBM's established procedures governing the use of such confidential disclosure forms is that no substantive modifications can be made to a confidential disclosure after it has been submitted to an IBM Patent Attorney/IP Professional.

Applicants exercised due diligence from prior to the effective dates of Phillips and Guigui to the date that the Application was filed. As expressly affirmed in the Declarations, Applicants, from at least the effective dates of Phillips and Guigui, through the filing of the Application on December 15, 2003, worked diligently toward a constructive reduction to practice of the invention. Applicants initially worked with IBM's own in-house Patent Attorneys/IP professionals during an internal review of the

invention, including assessing the invention in the context of related literature. Subsequently, Applicants worked with Patent Attorneys retained by IBM (outside counsel) to prepare and file the Application.

Outside counsel prepared the Application consistent with long-established professional practices, according to which cases are prepared on a first-in, first-out basis unless a particular application is associated with a bar date; those applications associated with bar dates are granted priority within the work queue. Outside counsel followed this professionally-accepted practice in preparing the Application in this case.

The written description and each of the claims of the Application were prepared based upon the Applicants' attached Disclosure. Moreover, according to IBM's established procedures governing the use of such disclosures and Applicants' sworn testimony in the Declarations, the inventors reviewed the Application prior to its submission to the U.S. Patent and Trademark Office in order to ensure that the claims and written description contained therein were fully supported by the Disclosure.

Other documentary evidence supporting Applicants' claims of due diligence is submitted herewith in the form of various supporting documents. Exhibit "A" is a series of communications from between Applicants and IBM's Patent Attorneys/IP Professionals regarding initial review of the patentability of the disclosure, dated between May 30, 2003 and June 19, 2003. Exhibit "B" sets forth the results of a patentability search that was requested by IBM's Patent Attorneys/IP Professionals. Exhibit "C" is a letter from an IBM Patent Attorney requesting outside counsel prepare the Application, dated September 22, 2003. Exhibit "D" is a letter from outside counsel confirming receipt of the instructions, dated October 2, 2003. Exhibit "E" is a series of communications (November 11, 2003 to December 1, 2003) requesting review and final approval of the Application drafted by outside counsel. Approval of the Application is evidenced by Applicants' signatures dated between December 1, 2003 and December 15,

2003 on the Declaration and Power of Attorney filed with the Application on December 15, 2003 (a copy is included in this response for convenience and labeled Exhibit "F").

Applicants respectfully submit that it was reasonable for them and the Assignee of their invention, IBM, to rely on outside counsel in preparing the Application, and that outside counsel acted with diligence. Applicants and outside counsel operated under the constraints of other work obligations while preparing the Application. As noted in MPEP § 2138.06, inventors and their patent attorneys are never required to drop all other work to deal with an issue in a patent application. Applicants therefore submit that Applicants and their Patent Attorneys diligently pursued completion and filing of the present application without any unreasonable delays.

Accordingly, Applicants respectfully submit that Applicants' Declarations, coupled with the documentary evidence of specific activity on specific dates, clearly evidences Applicants' prior conception and diligence in pursuing an actual and constructive reduction to practice from a time prior to the effective dates of Phillips and Guigui. Applicants therefore respectfully request withdrawal of the rejections under Phillips or Guigui.

#### **Claims Define Over the Cited References**

Even though Applicants respectfully maintain that Phillips and Guigui are not applicable references, Applicants nonetheless submit that the Claims, as amended, still define over the references of record. In the Office Action, the independent claims were rejected as being unpatentable over Faccin in view of Guigui and/or Phillips. Applicants respectfully disagree.

In particular, Applicants respectfully submit that Faccin fails to disclose or suggest a method of authenticating a mobile device in which the mobile device communicates using two different communications links. Specifically, Faccin fails to disclose the use of

both a mobile communications link over a mobile network and a wireless communications link over a wireless network. Faccin discloses a method of authentication of calls, which can include Session Initiation Protocol (SIP) calls. However, as discussed throughout the disclosure of Faccin, and as illustrated in FIGs. 1-4, all communication between the calling party and the SIP server occur over a single mobile communications link over the mobile network. Applicants respectfully submit that it is incorrectly assumed in the Office Action that only a single link is recited in the claims. Applicants direct attention to page 4 of the Office Action, lines 6-7, citing Faccin regarding a mobile node (mobile communications link) and stating that the reference discloses communications over a wireless network. However, nowhere does Faccin disclose or suggest using SIP to authenticate calls using communications over two types of networks.

In contrast, the claims explicitly recite that different communications occur over links in different networks. That is, a mobile network and a wireless network are defined to be different types of communications networks in the Specification. Mobile networks, as used in the claims, refer to wireless telephony networks. Wireless networks, as used in the claims, refer to wireless local data networks. (See, e.g., Specification, para. [0012], [0013].) To eliminate any confusion, Applicants, as previously noted, have amended the claims to explicitly identify communications links over these two networks.

Accordingly, Faccin, alone or in combination with any references of record, fails to disclose, suggest or render obvious each and every element of the independent claims as amended. Therefore, Applicants respectfully submit that the independent claims define over the references of record. Furthermore, as the remaining claims each depend from one of the independent claims while reciting additional features, Applicants submit that the dependent claims also define over the references of record.

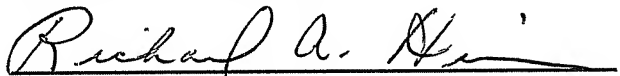
**CONCLUSION**

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

AKERMAN SENTERFITT

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